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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,337	06/27/2001	Daniel W. Doll	1082-503	1137

7590 11/06/2003
Joseph A. Walkowski
Traskbitt, PC
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Salt Lake City,, UT 84110

EXAMINER

MILLER, EDWARD A

ART UNIT PAPER NUMBER

3641

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,337

Applicant(s)

DOLL ET AL.

Examiner

Edward A. Miller

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3641

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-32 and 34-44, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Otani et al. '969 in view of Aubert et al. '668, Shepherd '000 and French 465,082.

Otani et al. teach the basic invention of melt cast explosives with dinitro aromatics, oxidizer, etc. In view of Aubert et al., Shepherd and French 465,082, variation of the various notoriously well known additives, amounts and so forth would have been obvious. Note that the broad recitations read on many and various dinitro aromatics as taught in the references, and that "oxidizer" reads on various oxidizers, including organic ones such as TNAZ of Aubert et al. In particular, Shepherd at col. 4, lines 5-6 suggests DNT, and at lines 14-18 following, that the amounts may be in the general range claimed by applicants. It is well settled that optimizing a result effective variable is well within the expected ability of a person of ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Indeed, some of these references may be the epitome of obviousness, anticipation, as to the broader claims. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

The properties or results of the compositions are inherent in the compositions. Where the product appears to be the same or only slightly different, the properties recited would appear to be inherent. The Office does not have testing facilities to determine such. The burden falls on applicant to show that the prior art products do not necessarily or inherently possess the claimed properties. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966; *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596; *In re Best*, 562 F.2d 1252, 1255; 195 USPQ 430, 433-434; *In re Brown*, 459 F.2d 531, 173 USPQ 685.

See the indefiniteness rejection in paragraph 6 below. It is not clear what the claims require, so applicants' arguments are not persuasive, as not relating to the claims as broadly understood.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. The instant claims are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the respective claims of copending Applications No. 09/893,336 and 09/747,303. Although the conflicting claims are not identical, they are not patentably distinct from each other because of clear overlap. In all cases, the basic ingredients are dinitro aromatic compounds with various additives. As claimed, the additives in the broadest claims of each case differ, but all the claims have the scope of "comprising". Thus, the claims are amenable to this rejection as currently written. Potentially, this may be overcome in prosecution by limitations added to the respective claims to better define patentability. However, applicant should take care to maintain a line of demarcation between the respective cases, particularly with the functional, last several claims. Applicants' arguments are not persuasive in view of the indefinite nature of the claims, and the apparent overlap, see paragraph 6 below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 3641

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-32 and 34-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims cannot be understood. Applicants urge that the claims require certain ingredients and in high amounts. However, consider claims 43-44 for the most extreme situation. The amounts of the recited ingredients appears to be required to be 99%. However, the scope of the claims is “comprising”, which allows addition of other ingredients and in major amounts. See MPEP 2111.03, wherein: “*Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) (“comprising” leaves ‘the claim open for the inclusion of unspecified ingredients even in major amounts’).” With 99% of everything specified, the scope of “comprising” makes no sense whatever. It is inconsistent with a correct recitation of 99% of the ingredients. Thus, it is not clear whether the amounts are not actually required, or if the claims scope is actually intended to be “consisting essentially of” or consisting of, which “limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).” [MPEP 2111.03.]

Similarly, all the remaining claims appear to be defective in the same manner, as to requiring 95% of fixed ingredients. Claim 23 further illuminates this further, as this claim requires the binder include a heterocyclic compound, but there is neither any antecedent for such in claim 15 from which it depends, nor is there any apparent requirement that such a heterocycle be a nitro-aromatic. From claim 1, for example, the binder is selected from mono- and di- nitro aromatics, and the other broad claims include similar language. This would appear to preclude any binder but mono- or di-

Art Unit: 3641

nitrosubstituted aromatics as the binder. This is particularly the case, since the last several lines of the independent claims require 95% combined binder and oxidizer, which is argued by applicants to require the recited nitro compounds and that such language defines over the prior art with other ingredients. In short, the metes and bounds of the claimed invention cannot be determined as currently written.

In claim 1, line 6 recites "oxidizers" while lines 10-11 recite "inorganic oxidizers". The latter has no antecedent basis, and it is not clear what is required, inorganic oxidizers, organic oxidizers, or maybe a mixture. This inconsistent language cannot be reconciled. In several places, N-methylnitroaniline, e.g., is set forth as a processing aid, such as in claims 7-8, while it appears to be a compound that would be mono-nitro-aromatic binder. This becomes an issue, particularly in view of the new limitations on ingredients of 95% or more, whether this processing aid is part of the binder and thus the 95% (or 99%) required ingredients. The entirety of the claim amendments is such that one cannot reasonably determine the metes and bounds of the claimed invention.

7. Applicant's amendments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

Application/Control Number: 09/893,337

Page 6

Art Unit: 3641

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em

October 30, 2003

A handwritten signature in black ink, appearing to read 'E. Miller', with a stylized flourish at the end.

**EDWARD A. MILLER
PRIMARY EXAMINER**